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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,590	06/16/2006	Sei-ichi Onoue	UNU94.001APC	8151
20995 7590 10/21/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
REDDY, KARUNA P				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
10/21/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

### Office Action Summary

**Application No.**

10/596,590

**Applicant(s)**

ONOU ET AL.

**Examiner**

KARUNA P. REDDY

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

1. This office action is in response to amendment filed 7/25/2008. Claims 5-19 are cancelled; and claim 23 is amended. Accordingly, claims 1-4 and 20-24 are currently pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

3. Claims 1, 4 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storrow et al (US 3,069, 375) in view of Swarup et al (US 5, 506, 325).

The rejection is adequately set forth in paragraph 4 of office action mailed 4/25/2008 and is incorporated here by reference.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Storrow et al (US 3,069, 375) in view of Swarup et al (US 5, 506, 325) as applied to claim 1 above, and further in view of Kano (US 5, 891, 948).

The rejection is adequately set forth in paragraph 5 of office action mailed 4/25/2008 and is incorporated here by reference.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Storrow et al (US 3,069, 375) in view of Swarup et al (US 5, 506, 325) as applied to claim 1 above, and further in view of Kano (US 5, 891, 948) and Gagliardi et al (US 5, 961, 674).

The rejection is adequately set forth in paragraph 6 of office action mailed 4/25/2008 and is incorporated here by reference.

6. Claims 1 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storow et al (US 3,069, 375) in view of Inagaki et al (US 4, 427, 823).

The rejection is adequately set forth in paragraph 7 of office action mailed 4/25/2008 and is incorporated here by reference.

7. Claim 1, 4 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger et al (US 6, 008, 291) and Swarup et al (US 5, 506, 325).

The rejection is adequately set forth in paragraph 8 of office action mailed 4/25/2008 and is incorporated here by reference.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger et al (US 6, 008, 291) and Swarup et al (US 5, 506, 325) as applied to claim 1 above, and further in view of Kano (US 5, 891, 948).

The rejection is adequately set forth in paragraph 9 of office action mailed 4/25/2008 and is incorporated here by reference.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger et al (US 6, 008, 291) and Swarup et al (US 5, 506, 325) as applied to claim 1 above, and further in view of Kano (US 5, 891, 948) and Gagliardi et al (US 5, 961, 674).

The rejection is adequately set forth in paragraph 10 of office action mailed 4/25/2008 and is incorporated here by reference.

***Response to Arguments***

10. Applicant's arguments, filed 7/25/2008, with respect to objection have been fully considered and are persuasive. The objection of claim 23 has been withdrawn in view of amendment.

11. Applicant's arguments, filed 7/25/2008, with respect to prior art rejections in paragraphs 4-10 have been fully considered but they are not persuasive.

Specifically, applicant argues that neutral silica sol of present claims is made by a process that produces structural and characteristic differences and is not the same as colloidal silica of cited prior art. The unexpected advantages can be seen from the Declaration submitted under 37 C.F.R. §1.132 and data in tables 1-8 of the originally filed disclosure.

However, showing of unexpected results should be based on trial runs that are conducted in a side-by-side manner i.e. only variable in the trial runs should be the inventive feature which in this case is neutral silica sol, per applicant's argument, and is used in an amount of 50 parts by weight. The examples that meet these criteria are inventive examples 1-6 and comparative example 2.

Inventive example 1 uses neutral silica sol with a pH of 7.6, inventive examples 2-6 use neutral silica sol having pH of 7.6 and are hydrophobized. On the other hand, comparative example 2 uses colloidal silica with a pH of 9.5. It is noted that, while Storow et al disclose a broad pH range of about 8.0 to about 10.0, examples in Storow et al use colloidal silica with a pH 8.4 (see table 1 of Storow et al). Thus, contrary to

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applicant's argument, comparative example 1-2 which uses colloidal silica having a pH of 9.5 is not the closest prior art of Storrow et al. Court held that evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. P. R./

Examiner, Art Unit 1796

/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1796